

Attorney Docket No. LANG-30273
Application No. 10/734,409

Amendment and Response Accompanying
Request for Continued Examination (RCE)

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Remarks

JUL 10 2006

Claims 75-145 are pending in the application. Claims 1-74 have been canceled.

The Examiner had made a final rejection of all the pending claims in the Office Action of March 10, 2006.

Applicant certainly appreciates the courteous assistance given by the Examiner in the phone interview of May 9, 2006. Pursuant to the phone discussions, Applicant is requesting continued examination with respect to the present application.

In considering the claims now presented, Applicant would have the Examiner consider the remarks that follow:

I. Rejections Under 35 U.S.C. §102(b)/ §103 Based on Sand et al.

The Examiner had previously rejected claims as being anticipated under 35 U.S.C. §102(b) or as being obvious under §103(a), based upon the reference Sand et al. (U.S. Patent No. 5,894,684) alone or in combination with McDonald (U.S. Patent No. 5,319,869) or Aveni (U.S. Patent No. 5,467,537).

An invention is said to be "anticipated" only if each and every element set forth in the claim is found, either expressly or inherently, within a single prior art reference. *Verdegall Bros. V. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). In order to establish a *prima facie* case of obviousness, the prior art references must teach or suggest all of the claim limitations when combined. See *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974); and MPEP 2143.03. Applicant respectfully submits that the Sand et al. reference, either alone or in combination with McDonald or Aveni, fails to disclose each and every element of Applicant's claimed invention and thus fails to anticipate or provide a *prima facie* case of obviousness of Applicant's presently pending claims.

Applicant's claimed invention is for a shoe that has a support system for supporting the ankle of a foot. The shoe support system is used to facilitate prevention of inversion and eversion movement of the ankle, which can lead to serious injury. The support system is particularly useful in athletic shoes of various types and may replace the athletic tape or "spatting" that is wrapped around the ankle and shoe to provide

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support. Because the support system is incorporated into a common shoe used for walking, running, etc., it is lightweight, compact and non-obtrusive.

In contrast, the device of Sand et al. is a snowboarding boot that is quite bulky, cumbersome, limits movement of the foot and functions in a different manner than a shoe that is used for walking, running and similar activities and without attachment or cooperation to another device, such as a snowboard. The device of Sand et al. is quite restrictive and would be undesirable and unsuitable for use in the activities contemplated in Applicant's invention, such as walking, running, jumping, etc. and in particular to athletic activities such as basketball, football, etc. (*see* specification page 13, lines 7, etc.) where a high degree of motion of the foot is required. Indeed, Applicant distinguished those devices in the background section, such as ski boots and roller blades, which are designed to isolate movement of the foot (*see* specification page 3, lines 25, etc.). Applicant submits this would also be the case with the snowboarding boot of Sand et al. and similar devices.

Because Applicant's shoe is configured for direct contact and non-binding engagement with the ground or other support surface, such as may occur in walking, running, jumping, etc., and where general flexing and movement of the foot is not impaired, the sole inliner may be generally flexible across the arch to facilitate such movement. This is described in Applicant's specification, such as at page 19, lines 14-20. Applicant's new independent claim 75, as well as new independent claims 96, 109 and 128, each require that the sole inliner to be generally flexible across the arch of the foot.

This is in direct contrast to the snowboarding boot of Sand et al. As described in Sand et al., the shank portion 12, which the Examiner contends constitutes a sole inliner, is described as being a rigid member that resists flex (*see* Abstract, line 6, etc. and column 5, lines 12, etc.) This is so that the shank portion functions as a rigid cantilever beam that facilitates control of the snowboard (*see* col. 5, lines 34, etc.). Thus, Sand et al. fails to disclose each and every element of Applicant's claimed invention. Additionally, modifying Sand et al. to provide flexibility across the arch would destroy its intended purpose. Applicant's independent claims 75, 96, 109 and 128 and those claims depending from them should be allowed over Sand et al. for at least this reason.

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New independent claim 96 further specifies that the back inliner is non-movably coupled to the sole inliner with the coupling. This is shown and described in Applicant's specification, for instance, at page 17, lines 5-13, and at the text starting at page 26, line 25 with reference to Figure 7A. Such shoe configuration has particular application to football and similar activities, where sudden bursts of speed over short distances, such as at the line of scrimmage in football, where the wearer pushes off and runs on the forward portion or toes of the foot. Sand et al. does not show such a non-movable coupling. Additionally, modifying Sand et al. to provide a non-movable coupling would destroy its intended purpose. Accordingly, claim 96 and those claims depending from it should therefore be allowed for this additional reason.

Claim 109 specifies that there is no cupping of the heel to hold the heel in a fixed position. This is supported by the specification as no such cupping is shown, described or contemplated from a reading of Applicant's specification. Applicant's invention is directed toward preventing inversion and eversion and is not for preventing the heel from movement within the shoe. Sand et al. discloses that the heel cup portion 14 locates and holds the heel in a fixed position to prevent "heel lift" which is detrimental to the control of the ankle support system (see column 5, lines 43, etc.). The device of Sand et al. facilitates isolating movement of the foot, as in a ski boot or roller blade. Additionally, modifying Sand et al. to remove the cup portion would destroy its intended purpose. Accordingly, claim 109 and those claims depending from it should therefore be allowed for this additional reason.

New independent claim 128 calls for the movable coupling to be located at a position below the ankle of the foot. This is not taught, shown or suggested in Sand et al. Sand et al. states that the heel cup portion 14 is designed to provide a forward or flexing or hinging motion *at the ankle joint*, thus mimicking the rider's natural ankle rotations (see column 5, lines 40, etc.). Claim 128 specifies that the coupling is located a position below the ankle of the foot such that no hinged motion occurs at the ankle joint. Claim 128 and those claims depending upon it should therefore be allowed for this additional reason.

For all of the above reasons, Applicant submits that all of the pending claims are allowable over Sand et al.

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II. Rejections Under 35 U.S.C. §103 Based on Borden and Quackenbush

The Examiner has rejected previously pending claims as being obvious under §103(a), based upon the reference Borden in combination with Quackenbush (U.S. Patent No. 6,102,881).

Applicant submits that the Borden and Quackenbush cannot be properly combined to provide a *prima facie* case of obviousness with respect to the presently pending claims. Applicants would remind the Examiner that proposed modifications or combinations of the prior art cannot render them unsatisfactory for their intended purpose or change the principle operation of the references. *See* MPEP §2143.01. Specifically, Borden discloses a spring shoe device that forces the foot *away from the shin* (*see* column 6, lines 17, etc.). In contrast, the device of Quackenbush urges the foot *toward the shin*, as indicated by the lifting force 30 (Fig. 1) for persons with drop foot (*see* column 3, lines 41, etc.). Thus, the two devices are designed for completely opposite purposes, forcing the foot in opposite directions. Combining the two references would thus destroy each of the device's function and purpose. Accordingly, Applicant respectfully submits that these references cannot be properly combined in the manner the Examiner suggests.

Additionally, by adding and positioning the coupling 16 of Quackenbush to the device of Borden, one would have to remove the spring strap 38 of Borden. This spring strap 38 is essential to the function of Borden because it stores energy, as described at column 5, lines 64, etc., and this effect is lost by providing the hinged coupling of Quackenbush at a position that coincides with the spring strap 38 of Borden.

Finally, each of Applicant's claims require the sole inliner to be flexible generally across the arch of the foot to facilitate walking, running or other activities. Applicant submits that by providing such flexibility in the device of Quackenbush the drop foot lifting function could not be achieved due to the flexible nature of the support structure.

Furthermore, even if the Examiner is still of the position that these references are properly combinable, the references fail to teach or suggest all of the claim limitations when combined.

With respect to independent claim 96, the back inliner is required to be non-movably coupled to the sole inliner. This is not shown by the combination of Borden and

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Quackenbush. Both Borden and Quackenbush require pivoting or flexing. Accordingly, these references fail to establish a case of *prima facie* obviousness for this reason. Claim 96 and those claims depending from it should therefore be allowed for this additional reason.

Independent claim 109 specifies that the relative movability of the back inliner and sole inliner are facilitated by the flexibility of materials of at least one of the coupling, back inliner and sole inliner. The flexibility of the back inliner and sole inliner to permit dorsiflexion and plantar flexion is described in the specification, for example, at page 16, lines 27, etc. It is also described with reference to the integral configuration of Figure 7A, that the coupling can be formed of a more flexible material (*see* page 27, line 4) that would also permit this dorsiflexion and plantar flexion. Both Borden and Quackenbush require a hinged connection to facilitate relative movement. Claim 109 and those claims depending from it should be allowed for this additional reason.

Independent claim 128 specifies that the movable coupling is located at a position below the ankle of the foot. Both Borden (column 4, line 46, etc. "ankle hinge axis 17") and Quackenbush (column 4, lines 17, etc.) specify that the hinge or bending is located at the ankle. Claim 128, as well as those claims depending from it, should therefore be allowed for this additional reason.

III. Conclusion

In view of all of the reasons presented above, Applicant submits that the application is in a condition for allowance. Favorable action is therefore respectfully requested.

If any further extension of time is believed necessary such extension is hereby requested. If any fees are deemed necessary for the continued prosecution of the present application, the Commissioner is hereby authorized to charge them to Deposit Account No. 50-1899.

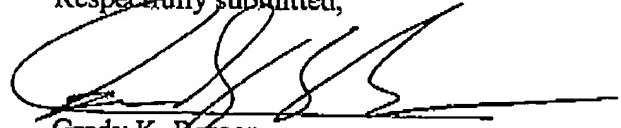
Please contact the undersigned at the address or telephone number listed below should there be any questions, or if contacting the undersigned would expedite or aid the examination or prosecution of this application.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Grady K. Bergen', is written over a horizontal line.

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